

The Applicants respectfully submit that the Office Action has failed to establish a *prima facie* case of obviousness of the present claimed invention.

It is well-established that the Office bears the initial burden of factually supporting a *prima facie* conclusion of obviousness. Generally, a *prima facie* case of obviousness may be established if there is some suggestion or motivation in either the references themselves or the general knowledge of one of ordinary skill to either modify or combine reference teachings in a way that achieves the claimed subject matter (see MPEP §2143; *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)). However, there can be no *prima facie* case of obviousness if: (1) the proposed modification renders the prior art device being modified unsatisfactory for its intended purpose or (2) the proposed modification changes a principle of operation of the modified device (see *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (If the proposed modification renders the prior art reference being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (The teachings of a reference are not sufficient to render claims *prima facie* obvious if the proposed modification or

combination of the prior art would change the principle of operation of the prior art invention being modified)). Thus, a rejection under 35 USC §103(a) is improper where a proposed modification either renders the modified prior art device unsatisfactory for its intended purpose or changes a principle of operation of the device.

The Applicant submits that the combined teachings of the applied references would not yield the subject matter defined by claims 14, 16, 18, 19, 21 and 23 because the hypothetical combinations suggested by the Final Rejection render Falck's invention unsatisfactory for its intended purpose and change a principle of its operation. Therefore, the Applicant respectfully submits that the obviousness rejections are unwarranted and improper.

Falck discloses, in Fig. 1, communication between a network and multiple servers represented by a common IP address (see Falck col. 1, lines 9-15). Liberti discloses communication between networks and mobile subscribers. Liberti's technical field is different from Falck's. Neither the cited references nor the Final Rejection presents any support for motivation for combining the teachings of Falck and Liberti. As a result, the Office has not met its burden in presenting a case of obviousness.

Furthermore, independent claim 14 recites a multimedia communication apparatus comprising a multiplexer that packages first control data and second control data to generate packaged control data and the first control data and the second control data concern abilities of the multimedia communication apparatus. Independent claim 19 recites a multimedia communication method in which first control data and second control data are packaged to generate packaged control data and the first control data and the second control data concern abilities of the multimedia communication apparatus. These features of claims 14 and 19 provide advantages in that the waiting time concerning transmission of control data can be shortened and the delay of the beginning of the transmission of stream data can be reduced (see specification page 5, lines 23-27).

The Applicant submits that the Final Rejection mistakenly equates Liberti's "data streams" (see Liberti col. 20, line 6) with the claimed "control data" recited in independent claims 14 and 19. Furthermore, Liberti does not disclose the feature of multiplexing the first control data and the second control data to generate packaged control data as recited in claims 14 and 19, for the following reasons.

The claimed "control data" concerns abilities of the multimedia communication apparatus, as recited in claims 14 and

19. The control data is exchanged between communication apparatuses and then stream data (such as voice data and other data) is transmitted (see specification page 1, lines 15-16, and page 1, lines 21-22). The stream data is main data that is transmitted between the communication apparatuses.

Conversely, Liberti discloses that the "data streams" (see Liberti col. 20, line 6) are a variety of information, such as voice data, real-time multimedia data, web data, and other data (col. 3, lines 3-14, column 8, line 22, and TABLE 1).

Liberti fails to teach or suggest that the "data streams" include control data that concerns abilities of the multimedia communication apparatus. Liberti's "data streams" are main data that is transmitted between the communication apparatuses.

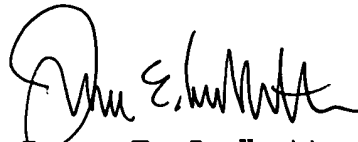
Accordingly, it is submitted that the combined teachings of Falck and Liberti fail to teach or suggest the subject matter defined by independent claims 14 and 19. Therefore, allowance of claims 14 and 19 and all claims dependent therefrom is warranted.

In view of the above, it is submitted that this application is in condition for allowance and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to telephone

the undersigned at the local Washington, D.C. telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James E. Ledbetter". The signature is fluid and cursive, with a large initial "J" and "L".

James E. Ledbetter

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JEL/DWW/att

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